

REMARKS/ARGUMENTS

The Examiner is thanked for the courtesy of the telephone interview which was held with the undersigned attorney on February 5, 2004. The arguments presented herein include those which were discussed with the Examiner during the telephone interview.

Claims 51-70 are currently pending in this application. In the Office Action mailed on October 6, 2003, the Examiner adhered to the previous rejection of claims 51-61 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,877,134 (Klein) patent in view Japanese Patent Publication No. 08-3044140 (Susumu et al.). The Examiner also adhered to the previous rejection of claims 62-70 under 35 U.S.C. § 103(a) as being unpatentable over Klein '134 in view of Susumu et al. as applied to claims 51-61, and further in view of U.S. Patent No. 5,609,778 (Pulaski et al.).

As pointed out by the Applicants during the telephone interview, the combination of prior art references relied upon by the Examiner in the § 103(a) rejections lacks at least two recited features of the presently claimed invention. First, although the Klein '134 patent discloses in Fig. 4 the association of bar codes with test tubes before samples are placed into the tubes, there is no indication that these bar codes are *universally unique* in the sense intended by the present invention. ("Unique" means that no two containers have the same identifying marking, while "universal" indicates that the uniqueness of the container identifier is preserved across institutional or organizational boundaries.) The Klein '134 patent makes no mention of universal uniqueness, nor of other factors from which the presence or absence of universal uniqueness might be inferred (e.g., whether the bar codes are applied by the manufacturer or by the end user, how the bar codes are assigned or determined, and so on). The Office Action does not indicate the reasons for the Examiner's belief that the bar codes of the Klein '134 patent are universally unique, if that is in fact the Examiner's position.

The second feature of the present invention that is missing from the combination of prior art references relied upon by the Examiner is any equivalent of the first database (i.e., the container information database) recited in Applicants' independent claim 51. As mentioned in the previous Amendment filed on September 22, 2003, the Klein '134 patent does not mention databases at all; however, even if it can be assumed that the purpose of the bar codes shown in Fig. 4 is to provide a link to information in an undisclosed database, such information would clearly be information about the samples rather than information about the tubes themselves. Similarly, the Susumu et al. reference discloses only a single database 17 which contains only sample (or patient) information rather than container information.

As pointed out during the telephone interview and earlier during the prosecution of this application, the fact that the Klein '134 patent lacks both a container information database and any mention of universally unique container identifiers is not surprising. In the context of the present invention, these two features are related, in that the container information database provides a mechanism by which the universal uniqueness of the container identifiers can be assured (see, e.g., the description of the preferred embodiment at page 21, lines 8-20 of the Applicants' specification). If universally unique identifiers are not required, the container information database may likewise not be required. It is reasonable to assume that such is the case in the Klein '134 patent, since neither feature is mentioned.

It is well settled that, in order to establish obviousness under 35 U.S.C. § 103(a), all of the claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03; see also *CFMT, Inc. v. Yieldup International Corp.*, 349 F.3d 1333 (Fed. Cir. 2003) (“[O]bviousness requires a suggestion of all limitations in a claim”), citing *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983), and *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Because of the absence from the prior art references relied upon by the Examiner of the universally unique container identifier and first database of Applicants' claim 51, the present rejections do not comply with this rule.

In the Office Action, the Examiner appears to concede that at least the first database of claim 51 is missing from both the Klein '134 and Susumu et al. references, but states that the use of such a database would have been obvious to one of ordinary skill in the art. In support of this conclusion, the Examiner suggests that such a database would be advantageous in allowing “the container information and content information [to] be easily stored and easily retrieved”. The Examiner further suggests that “[u]sing a [container information] database would also allow for information on multiple container[s] and samples to be present in a central location making information retrieval by the user quick and easy”. Finally, the Examiner contends that “[b]ecause Klein teaches that barcodes are associated with the individual tubes and later associated with the contents of the tubes, it would have been obvious to one of ordinary skill in the art to have two databases -- one for the tubes themselves and one for the contents of the tubes”.

The Applicants respectfully suggest that the Examiner’s above-quoted reasoning is the product of hindsight, which is not a permissible basis for a finding of obvious under 35 U.S.C. § 103(a). See, e.g., *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998) (“This court forbids the use of hindsight in the selection of references that comprise the case of obviousness”), and *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The advantages enumerated by the Examiner would only be apparent to one of ordinary skill in the art who had prior knowledge of the Applicants’ invention. They would not occur to one who did not have such knowledge. The Federal Circuit has also held that the suggestion or motivation to modify a prior art reference in support of a rejection under § 103 (a) must be based on evidence, not on conclusory statements. *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000), citing *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). In the present case, the Applicants respectfully suggest that the statements in the Office Action to the effect that the use of a container information database would have been obvious are conclusory in nature and are not supported by evidence drawn from the prior art references themselves, or by evidence of what would or would not have been within the knowledge of one of ordinary skill in the art at the time the invention was made.

The Applicants believe that an unstated premise underlying the Examiner's rejection under 35 U.S.C. § 103(a) may be the belief that, since the Klein '134 patent illustrates sequentially-numbered bar code labels 31-38 in Fig. 4, a database equivalent to the first database of Applicants' claim 51 must have been used to generate these bar codes. As discussed during the telephone interview, such an assumption is not justified. In a Second Supplemental Information Disclosure Statement that is being filed concurrently with this Response, the Applicants are making of record U.S. Patent No. 4,917,011 (Bernauer). The Bernauer '011 patent describes a bar code printer which operates in a purely mechanical fashion to print bar codes representing successive numbers. No database is used, and none is needed. While it is not known precisely what type of bar code printer might have been intended for use in printing the bar codes shown in Fig. 4 of the Klein '134 patent, it is certainly possible that a sequential mechanical printer of the type disclosed in the Bernauer '011 patent might have been intended. Since no database is required for such a printer, it follows that there is no reason to assume that the Applicants' first database is an inherent or obvious feature of the Klein '134 patent.

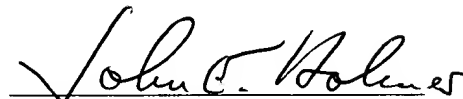
The Pulaski et al. '778 patent is cited in the Office Action as a secondary reference in the rejection of dependent claims 62-70 under 35 U.S.C. § 103(a). This reference is relevant only for its disclosure of laser marking of glass and plastic surfaces. It does not suggest the use of universally unique container identifiers or the use of a container information database. Thus, it does not remedy any of the deficiencies of the Klein '134 and Susumu et al. references discussed above in connection with claims 51-61.

At the conclusion of the telephone interview, the Examiner indicated that the arguments presented by the Applicants' representative had merit but that further review would have to be undertaken before reaching a decision on whether to allow the application. Should such review indicate additional that claim amendments are necessary in order place the application in condition for allowance, or that there is some other reason why the application cannot be allowed

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on the basis of the present record, the Examiner is asked to contact the undersigned attorney by telephone before issuing a further action on the merits.

Respectfully submitted,



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